

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: July 16, 2009 Name: Vincent J. Gnoffo, Reg. No. 44,714

Signature: 

PATENT
CASE NO. 8285/671

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Marc Ira Lipton, et al.

Examiner: Simon Sing

Serial No. 10/772,674

Group Art Unit No.: 2614

Filing Date: February 4, 2004

For Method and System for Ordering a
Telecommunication Service

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

This Appeal Brief is filed based on the final rejection of all pending claims mailed on August 29, 2008, and further to the Notice of Panel Decision from Pre-Appeal Brief Review mailed April 9, 2009.

I. Real Party in Interest

The real party in interest for the above-referenced application is AT&T Intellectual Property 1, L.P., 645 East Plumb Lane, Reno, Nevada 89502. See Reel/Frame 022457/0815.

II. Related Appeals and Interferences

The undersigned is unaware of any other appeals or interferences that will directly affect, be directly affected by or have any bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 34-57 are pending and stand finally rejected. Claims 1-33 are cancelled. All of finally rejected claims 33-57 are appealed.

IV. Status of Amendments

No amendments are pending.

V. Summary of Claimed Subject Matter

Independent claim 34 recites a system for providing a session for ordering a telecommunication service. Spec. p. 2, ll. 9-12, Fig. 2. The system comprises a receiver associated with the telecommunication service to receive, during a telecommunications call, a reply message to a terms and conditions contract message regarding terms and conditions of a contract. Spec. p. 4, ll. 16-25, Figs. 1 and 2. A processor is in communication with the receiver. Spec. p. 7, ll. 27-30, Fig. 2. A database is in communication with the processor. Spec. p. 7, ll. 15-17, Fig. 2. The processor creates a record of the session in the database, wherein the database maintains a recorded audio representation of at least a portion of the telecommunication call which documents that an individual has affirmatively accepted the terms and conditions, (Spec. p. 5, ll. 5-18., p.7, ll. 15-17, Figs. 1 and 2) wherein the terms and conditions are accepted without a service contract. Spec. p. 8, ll. 1-12, Fig. 1.

Independent claim 46 recites a method for ordering a telecommunication service via a telecommunications call. Spec. p. 2, ll. 9-12, Fig. 2. The method comprises communicating a terms and conditions contract for the telecommunication service to an individual ordering the telecommunication service. Spec. p. 4, ll. 16-25, Figs. 1 and 2. A record is maintained including a recorded audio representation of at least a portion of the telecommunication call which documents that an individual has affirmatively accepted the terms and conditions contract (Spec. p. 5, ll. 5-18., p.7, ll. 15-17, Figs. 1 and 2) without a service contract, (Spec. p. 8, ll. 1-12, Fig. 1) wherein the maintaining of the record occurs with the use of processor in communication with a database. Spec. p. 7, ll. 15-17 and 27-30, Fig. 2.

VI. Grounds of Rejection to be Reviewed on Appeal

Whether claims 34-57 are unpatentable over Edwards et al. (US 5,819,029) in view of O'Neal et al. (US 5,887,253).

VII. Argument

The Final Office Action does not correctly address missing elements of the claims. Appellant sets forth missing elements below.

A. Claim 34

Claim 34 recites a system for providing a session for ordering a telecommunication service "wherein the database maintains a recorded audio representation of at least a portion of the telecommunication call which documents that an individual has affirmatively accepted the terms and conditions, wherein the terms and conditions are accepted without a service contract."

The Office Action is incorrect that Edwards et al. and O'Neal et al. teach verifying, without a service contract, accepting terms and conditions. In both Edwards et al. and O'Neal et al., there is a service contract in place when the terms are verified. The claims, however, recite that terms and conditions of a contract are accepted without a service contract.

Edwards et al. tries to address problems that may occur when a customer switches a long distance service but denies ever having given the authorization to switch the service. Edwards et al. relates to a third party verification system of the service contract that's in place. A customer database manager contacts the customer and, responsive to the customer's authorization to switch a long distance carrier, creates a text file of the customer's responses to a series of questions supporting the authorization to switch the service. The service contract is existing in Edwards et al. when the inquiries occur. O'Neal et al. relates to identifying and validating a telephone for activating and servicing a cellular telephone service. See Abstract and Col. 1, ll. 5-10. In step 217, a voice response unit plays recorded messages to the customer concerning the terms and conditions of the cellular service, charges and payments, and any other contract provisions which the customer must acknowledge and accept. The voice response unit then instructs the customer to indicate acceptance of the terms and conditions by pressing a key or speaking a specified word or phrase, in order to activate the telephone. See Col. 13, ll. 18-25. The description of O'Neal is silent with regard to the terms and conditions being accepted without a service contract.

Conversely, under the tariff system, it is desirable to fully and accurately convey the terms and conditions of an untariffed telecommunication service to a subscriber without requiring the subscriber to sign a service contract. The claims recite that "the terms and conditions are accepted without a service contract." In other words, there is no existing service contract when the terms and conditions are accepted. The processor then "creates a record of the session in the database, wherein the database maintains a recorded audio representation of at least a portion of the telecommunication call which documents that an individual has affirmatively accepted the terms and conditions."

For at least these reasons, Applicants respectfully request review of the final rejection directed against the current application and withdrawal of the rejections against the claims.

B. Claim 46

Claim 46 recites a method for ordering a telecommunication service via a telecommunications call which maintains "a record including a recorded audio

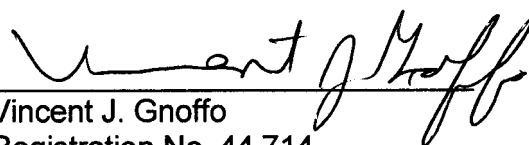
representation of at least a portion of the telecommunication call which documents that an individual has affirmatively accepted the terms and conditions contract without a service contract, wherein the maintaining of the record occurs with the use of processor in communication with a database.”

As discussed above, the Office Action is incorrect that Edwards et al. and O'Neal et al. teach verifying, without a service contract, accepting terms and conditions. For at least these reasons, Applicants respectfully request review of the final rejection directed against the current application and withdrawal of the rejections against the claims. For at least these reasons, Appellant respectfully requests review of the final rejection directed against the current application and withdrawal of the rejections against the claims.

Conclusion

For the reasons provided above, Appellant submits that claims 34-57 are allowable over the cited art. Appellant respectfully submits that the outstanding rejections of the claims as unpatentable is in error and should be reversed.

Respectfully submitted,



Vincent J. Gnoffo
Registration No. 44,714
Attorney for Appellant

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200

VIII. Claims Appendix

Claims 1-33: Cancelled

34. A system for providing a session for ordering a telecommunication service, the system comprising:

a receiver associated with the telecommunication service to receive, during a telecommunications call, a reply message to a terms and conditions contract message regarding terms and conditions of a contract;

a processor in communication with the receiver;

a database in communication with the processor; and

wherein the processor creates a record of the session in the database, wherein the database maintains a recorded audio representation of at least a portion of the telecommunication call which documents that an individual has affirmatively accepted the terms and conditions, wherein the terms and conditions are accepted without a service contract.

35. The system of claim 34 wherein the reply message includes a spoken message indicative of acceptance of the terms and conditions contract.

36. The system of claim 34 wherein the record includes subscriber identification information.

37. The system of claim 34 wherein the record includes service identification information.

38. The system of claim 34 wherein the record includes a time and at which the telecommunication service is ordered.

39. The system of claim 34 wherein the record includes a calling party identification for the telecommunication call.

40. The system of claim 34 wherein the recorded audio representation is of a substantially entire portion of the call to document that the individual has affirmatively accepted the terms and conditions contract.

41. The system of claim 34 further comprising at least one of a printer and a facsimile machine to generate a written confirmation of the terms and conditions contract.

42. The system of claim 34 wherein the terms and conditions contract message includes a verbal message.

43. The system of claim 34 wherein the telecommunication service includes a telephone service.

44. The system of claim 34 wherein the telecommunications call includes a voice call.

45. The system of claim 35 wherein the processor at least one of connects the individual to an operator and terminates the telecommunication call if the individual fails to affirmatively accept the terms and conditions contract.

46. A method for ordering a telecommunication service via a telecommunications call, the method comprising:

communicating a terms and conditions contract for the telecommunication service to an individual ordering the telecommunication service; and

maintaining a record including a recorded audio representation of at least a portion of the telecommunication call which documents that an individual has affirmatively accepted the terms and conditions contract without a service contract, wherein the maintaining of the record occurs with the use of processor in communication with a database.

47. The method of claim 46 wherein the record includes information to identify the individual.

48. The method of claim 46 wherein the recorded audio representation is of a substantially entire portion of the telecommunication call.

49. The method of claim 46 further comprising communicating a written confirmation which includes the terms and conditions contract to the individual.

50. The method of claim 49 wherein the written confirmation is communicated by at least one of mail, a delivery service or fax.

51. The method of claim 46 wherein the terms and conditions contract message includes a verbal message.

52. The method of claim 46 wherein the telecommunication service includes a telephone service.

53. The method of claim 46 wherein the telecommunication call includes a voice call.

54. The system of claim 34 wherein the terms and conditions contract message includes an instruction on how to accept the terms and conditions.

55. The system of claim 54 wherein the terms and conditions contract message further includes an instruction on how to reject the terms and conditions.

56. The method of claim 46 further including providing an instruction on how to accept terms and conditions of the terms and conditions contract.

57. The method of claim 56 wherein the instruction on how to accept terms and conditions of the terms and conditions contract further includes an instruction on how to reject the terms and conditions contract.

IX. Evidence Appendix

None

X. Related Proceedings Appendix
None